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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/825,332 Confirmation No. : 7895
First Named Inventor : Norbert ERHARD
Filed : April 16, 2004
TC/A.U. : 3752
Examiner : T. McGraw

Docket No. : 028972.53933US
Customer No. : 23911

Title : Spray Head for a Spraying Tool

REPLY

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following remarks are respectfully submitted in response to the final Office Action dated July 5, 2005.

The provisional rejection of claim 10 on grounds of non-statutory double patenting over claim 11 of co-pending application no. 10/825,621 is respectfully traversed. The Office Action alleges that the subject matter claimed in the instant application is fully disclosed in the referenced co-pending application. This is incorrect.

Claim 10 relates to a spray head for a spraying tool comprising (i) a plurality of modular spray units each having an end and a plurality of passages for the media to be sprayed, wherein the end of each spray unit has a chamber; (ii) a plurality of coupling elements, which communicate with the passages and reach into both chambers at the ends of the spray units that are joined, each coupling element including a passage and a recess having a tapered surface; and

(iii) a clamp that engages the tapered surface and presses the joined spray units together. These structural features are not disclosed by claim 11 of the co-pending application.

Pointing to specific elements (i.e., connecting pieces, passages, blocks and plates) recited in the claims of the co-pending application, the Office Action incorrectly concludes that these elements “affirmative suggest” the claimed coupling element. In contrast, the structural features of the claimed coupling elements cannot be found in these connecting elements. For example, there is absolutely no disclosure much less any suggestion of coupling elements that reach into chambers at the ends of joined spray units, or that each coupling element including a recess having a tapered surface. Furthermore, there is no disclosure in any of the claims of the co-pending application of a clamp that engages a tapered surface and presses the joined spray units together. The Office Action fails to even address the required clamp.

Unable to point to specific disclosure of the claimed structural features, the Office Action dismissively concludes that the connecting elements recited in the co-pending claims “must have a way for clamping or attaching these elements together.” Such conjecture is not a proper foundation for a *prima facie* case of obvious, nor does it substantiate full disclosure of the claimed subject matter in the claims of the co-pending application.

Moreover, in making the double-patenting rejection, the Office Action improperly relies upon the holding in *In re Schneller*, 397 F.2d 350, 158 USPQ

210 (CCPA 1968). According to the facts of *In re Schneller*, the original application disclosed ABCXY and the issued patent claimed a clip comprising BCX and ABCX such that ABCXY was effectively covered. In a subsequently-filed application, the court thus rejected claims directed to ABCY and ABCXY holding that granting such claims would afford the patent owner an extension to the protection he already had beyond the expiration of the original patent.

Applicants note that the decision in *Schneller* “did **not** establish a rule of general application and thus is limited to the particular set of facts set forth in that decision.” MPEP § 804. Indeed, the MPEP acknowledges that “non-statutory double patenting rejections based on *Schneller* will be rare” (emphasis in original). In the present case, the facts are clearly distinguishable over *Schneller*.

In contrast to the facts of *Schneller*, the co-pending application does **not** disclose all of the elements recited in, and thus required by, the claims of the present application. First, the co-pending application does not disclose coupling elements that communicate with the passages and reach into chambers at the ends of the spray units that are joined. Second, the co-pending application does not disclose coupling elements including a passage and a recess having a tapered surface. Finally, the co-pending application does not disclose a clamp that engages a tapered surface and presses the joined spray units together.

As clearly set forth in MPEP § 804, a non-statutory double patenting rejection based solely on improper timewise extension of patent rights with

another application should be made **only** when the subject matter of the claims is fully disclosed in, and covered by at least one claim of another co-pending application. Because the subject matter of claim 10 is not fully disclosed in the co-pending application, much less in claim 11, the rejection is improper and should be withdrawn.

The rejection of claims 10-17 and 19 under 35 U.S.C. § 102(b) over Wollin, US 5,916,367, is respectfully traversed.

Independent claim 10 relates to a spray head for a spraying tool, and independent claim 19 relates to a method of making a spray head for a spraying tool. Each of these claims requires, in pertinent part, that the coupling elements include a passage and a recess having a tapered surface, and that a clamp is used to engage the tapered surface and press joined spray units together.

Wollin discloses a spraying-tool head wherein a spray plate 11 onto which spray nozzles 4 are arranged is threadedly connected to a distribution plate 9 (see paragraph bridging columns 4 and 5). Wollin further discloses that the individual plates and modules, as well as the spray nozzles, may be threadedly connected to each other in a modular fashion (column 5, lines 5-8). For example, clamping together of individual plates can be done using threaded bolts (column 6, lines 1-3). However, Wollin does not disclose or suggest coupling elements including a passage and a recess having a tapered surface, much less that a clamp is used to engage the tapered surface and press joined spray units together.

In order to establish anticipation under 35 U.S.C. § 102(b), **all** elements of the claim must be found in a single reference. MPEP § 2131. Wollin merely discloses the use of conventional threaded bolts to clamp individual components together. Disadvantages associated with the conventional use of threaded bolts as taught by Wollin are discussed, for example, in the Background and Summary section of the instant application. Because Wollin clearly fails to anticipate or render obvious the claimed subject matter, reconsideration and withdrawal of the rejection are respectfully requested.

In view of the foregoing, the application is respectfully submitted to be in condition for allowance, and prompt favorable action thereon is earnestly solicited.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned at (202) 624-2995 would be appreciated since this should expedite the prosecution of the application for all concerned.

Serial No. 10/825,332
Reply to Office Action
October 3, 2006

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #028972.53933US).

Respectfully submitted,

October 3, 2006



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